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OSHA LIANG L.L.P. TWO HOUSTON CENTER 909 FANNIN, SUITE 3500 HOUSTON, TX 77010			EXAMINER HUYNH, SON P	
			ART UNIT 2424	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com  
buta@oshaliang.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/744,215	<b>Applicant(s)</b> AGASSE, BERNARD	
	<b>Examiner</b> SON P. HUYNH	<b>Art Unit</b> 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15 and 31-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15 and 31-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed June 24, 2009 have been fully considered but they are not persuasive.

Applicant argues the claimed limitation recited above requires (i) that the service menu, in its entirety, is inactive during the time that the interactive message is displayed; and (ii) that the interactive message, though displayed, is suppressed, when the service menu is in active form... in fact, there is no explicit disclosure in Alexander regarding any of the windows/menus on the television screen being inactive during the displaying of the notification message. Even if the notification message is overlaid completely on the underlying window(s), the underlying window(s) can and very well may be still active. Inactive, by definition, means that the menu cannot be accessed and even if accessed, cannot respond to any input...Thus, Alexander fails to disclose or render obvious the limitation recited in (i) and (ii) above (pages 2-3). This argument is respectfully traversed.

It is noted that the claims neither recite (i) the service menu, in its entirety, is inactive during the time that the interactive message is displayed nor (ii) the interactive message, though displayed, is suppressed, when the service menu is in active form; but instead, claims 15 and 42 recite "wherein the service menu is displayed in inactive form

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when the at least one interactive message is displayed, and wherein the at least one interactive message is suppressed when the service menu is active.

In addition, the office action states "since the notification is displayed in TV mode and/or the user response to notification on the screen and/or all sorts of possibilities for on screen notification, Alexander obviously suggest the service menu is displayed in interactive form when the at least one interactive message is displayed (e.g., the service menu is displayed as inactive form until the user response to notification or until the notification disappears). Therefore, there is no need for "explicit disclosure in Alexander to describe television screen being inactive during the displaying of the notification message, in stead, the obviousness is based on one of ordinary skill in the art.

Furthermore, Alexander reference is relied on for obviously suggesting the service menu is displayed in inactive form when the at least one interactive message is displayed. For example, provisional application No. 60,055,761 discloses New UI screen cuts out one half hour of grid and replaces it with 3 windows. PIP occupies 1/9 of screen. Initially, when entering the guide from the tv mode, the PIP window is highlighted but no show is highlighted in the guide. PIP highlighting may be a border change of color--not yet decided. With PIP highlighted, a program is recorded by pressing the record key of the remote.

By locking PIP, user can see what is on without leaving the channel you were watching. If you then unlock the PIP, the highlighted program appears in the PIP (page 3, lines 14-25). Alexander (provisional application No. 60,055,761) further discloses notification on screen to alert the viewer of an event is in VG: an on screen notice in the tv mode that a

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program will be recorded in 2 minutes with a query of whether to switch the cable 20 box to record the program. If the answer is "no", the program is deleted from the record list. There are all sorts of other possibilities for on screen notifications (page 6, lines 17-23); and when you are watching a tv show and it is time to record a show on another channel, a notice appears of the screen. "Press one button to change channels and press another button to cancel the record reservation." Notices can be transmitted with the tv signal to display to selected viewers (page 23, lines 12-17). Alexander also discloses if the television is in television mode, the notification will be display on-screen. If the television is in some mode other than the television mode, for example, television is in Grid Guide mode in PIP format, the notification can be displayed in a number of ways, including: 1) a complete screen overlay.... (col. 14, line 42-col. 15, line 31). (According to free online dictionary, "inactive" definition includes lying idle, unused, out of use.). Thus, the limitation "interactive form" is interpreted as either service menu is not displayed when the interactive on screen notification is displayed (for example, in television mode/full screen television mode) or menu service of one half hour is cut out of the screen and/or when the screen is locked and/or when the service menu is completely overlaid by the on screen notification (in this case, it is obvious to one of ordinary skill in the art that the user has to suppress or do something to the on screen notification (e.g., suppress or minimize or move the on screen) before the user can see information on service menu).

It is further noted that the Examiner need not give patentable weight to non functional descriptive material absent a new and unobvious functional relationship

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between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004) *Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (Informative Opinion) (Affirmed, Rule 36, Fed. Cir., slip op. 06-1003, June 2006) ("Common situations involving non-functional descriptive material [include] .... a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer). In this case, the phrase "the service menu is displayed in inactive form when ...." as claimed, does not functionally change Alexander's system over how it operates with respect to the displaying on screen notification and service menu on television screen.

For the reasons given above, rejections on the claims are sustained and discussed below.

Claims 1-14, 16-30 have been canceled.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15 and 31-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. (US 6,536,041 B1) in view of Schein et al. (US 6,732,369) and further in view of Alexander et al. (US 6,177,931).

Note: Alexander references claims benefit to prior provisional application, and therefore, these provisional applications and all documents incorporated by references in Alexander references or in the provisional applications are treated as part of the specification of Alexander reference.

Regarding Claim 15, Knudson discloses a method for providing a user with options for accessing at least one of a plurality of received channels comprising at least one channel and a service channel of a digital television system (see figures 1-3, 6, 13, 24) comprising the steps of:

generating a service menu for display on a display superimposed over a program transmitted on one of the received channel, the service menu comprising a list of menu items corresponding to a plurality of service available to a user (interpreted as user presses a remote control play key or suitable button (e.g., to make on screen menu selection), the program guide displays the controllable ticker on a display superimposed over a program transmitted one received channel (e.g. channel 4), the controller tickers comprises categories such as major league baseball, national Football league, NHL, news, etc. the user may select from different categories that are available— see include, but not limited to, figures 13, 14a, col. 8, lines 20-26; col. 13, line 49-col. 14, line 67);

generating, upon user selection of one of the listed services from the service menu, at least one subsidiary menu for display on the display superimposed over the program together with only the selected menu item corresponding to the selected one of the listed services to provide the user with a plurality of options for accessing at least one of the received channels (interpreted as user selects a particular category, e.g. Major League Baseball, a menu for selected category is generated and displayed superimposed over video for channel 4 together with only selected category, the selected category provides the user with a plurality of option for accessing at least one of the received channel such as user selects a received channel for displaying ORIOLES AT RED SOX, select TV icon 187 for record a program, tune to a program, set a reminder, etc. – see figures 13-14b; col. 13, line 50-col. 14, line 67), wherein the selected menu item is originally displayed in a first location of the display, and wherein upon selection, the selected menu item remains in the first location of the display (interpreted as the selected category, for example, Major League Baseball, is originally displayed in the location of controller ticker 186, and upon user selection of the Major League Baseball category, The MLB remains in the location of the controller ticker 186– figure 13, col. 13, line 50-col. 14, line 67);

Knudson also discloses the menu as a controller ticker (figure 13). Thus, interference with the program is minimal.

Knudson further discloses generating and displaying messages such as a reminder for program (col. 8, lines 31-35; col. 9, lines 40-62). However, Knudson does not specifically disclose interactive message superimposed over the program, wherein



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the interactive message require a response from the user, and wherein the interactive message changes to the at least one of the received channels based on a positive reply from the user, and carrying out at least one payment step in response to a positive response to the interactive message from the user.

Schein discloses interactive message superimposed over the program (interactive messages in Informenu 530 (or subsequently interactive message(s) in response to selection of a link in informenu) superimposed over the program - see include, but are not limited to, figures 17a-18e), wherein the interactive message require a response from the user (the interactive messages in Informenu/or associated with links in informenu requires user selection – see include, but are not limited to, figures 17a-18e, col. 23, lines 20-65), and wherein the interactive message changes to the at least one of the received channels based on a positive reply from the user (e.g., in response to user selection of the message, changes to the selected channel to received the selected program – see include, but are not limited to, figures 17a-18e, col. 23, lines 20-65), and carrying out at least one payment step in response to a positive response to the interactive message from the user (in response to user selection of particular service or item requiring a financial transaction, a purchase sequence unfolds, the viewer is prompted to enter master password, access code such as swipe the viewer credit card through a slot of the remote control – see include, but are not limited to, figures 17a-18e, col. 23, lines 43-65); wherein the at least one interactive message is suppressed when the server menu is active (e.g., when the user select "go back to program guide" or "back to previous menu" the currently message being displayed is

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dismissed/suppressed - see include, but are not limited to, figures 17a-18E). Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to modify Knudson to use the teaching as taught by Schein in order to yield predictable result such as to improve convenience for user to order interest channel/program.

Knudson further discloses providing interactive messages including reminder to display with the menu (see include, but are not limited to, col. 8, lines 31-35, col. 9, lines 40-62). However, Knudson does not explicitly disclose the service menu is displayed in inactive form when the at least one interactive message is displayed.

Alexander discloses display multiple windows on the television screen; notification is displayed on the screen and the user response to the notification; There are all sorts of other possibilities for on screen notifications (see include, but are not limited to, provisional application No. 60,055,761: page 3, lines 14-25, page 6, lines 17-23, page 23, lines 12-17). Alexander later discloses on screen notification message is displayed in a number of ways, including 1.) a complete screen overlay; 2.) a partial screen overlay... the EPG screen in Grid guide mode; (see include, but are not limited to, col. 14, line 47-col. 15, line 31). Since the notification is displayed in TV mode and/or the user response to notification on the screen and/or all sorts of possibilities for on screen notification, Alexander obviously suggest the service menu is displayed in inactive form when the at least one interactive message is displayed (for example, the service menu is displayed in inactive form until the user response to notification or until the notification disappears, wherein the "inactive form" is interpreted as service menu is

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not displayed when on screen notification is displayed (e.g., in television/full screen television mode), or when one half hour of service menu is cut out or when service menu is completely overlaid by the on screen notification – see also discussion in “response to arguments” above.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Knudson with the teaching as obviously taught by Alexander in order to yield predictable results such as allowing user to activate desired content.

Regarding Claim 31, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 15. Knudson further discloses the list of services contained in the service menu (controllable ticker) is varied according to user's preferences (col. 16, lines 40-53).

Regarding Claim 32, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 15. Knudson further discloses the list of services contained in the service menu (controllable ticker) is ordered according to the preferences of the user (col. 14, line 28-col. 15, line 14).

Regarding Claim 33, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 15. The additional limitation of “control signals are received from a remote control handset” is either met by control signals are received

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from a remote control (e.g. remote control 60 or input device, Knudson, figure 1, col. 7, lines 50-62) or (user input or remote control, see figure 1, 11-12, col. 23, lines 43-65).

Regarding Claim 34, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 33. The additional limitation of “the service menu is generated for display on the display in response to the touch of a single dedicated key on the handset” is read on either Knudson’s disclosure of the screen menu on controller ticker is generated and displayed when user presses a remote control play key or other suitable (e.g. guide button to make an on screen selection) – col. 8, lines 20-22, col. 14, lines 39-44).

Regarding Claim 35, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 33. The additional limitation of “the display of the list of service contained in the service menu is scrolled in response to command received from navigation keys of the handset” is read on Knudson’s disclosure (see figure 14b, col. 15, lines 30-54).

Regarding Claim 36, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 15. Knudson further discloses the service menu is scrolled around a fixed bar displayed on the display (interpreted as scrolling around fixed controller ticker – see include, but not limited to, figure 14b, col. 15, lines 30-54).

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Regarding Claim 37, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 36. Knudson further discloses that the fixed bar (e.g. controller ticker) include navigations arrows showing possible directions of movement of the service menu (e.g. Up arrow, down arrow, left arrow, right arrow – figure 13).

Regarding Claim 38, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 15. The additional limitation of “upon user selection one of the option from the subsidiary, a second subsidiary menu is generated for display on the display superimposed over the program together with the selected one of the listed services to provide the user with a plurality of further options for accessing at least one of the received channels” is read on Knudson’s disclosure of upon selection of down arrow from a particular associated item, a “subsidiary menu” of next associated item is generated for display on the displayed superimposed over the video for channel 4 together with the selected category, the “subsidiary menu” of the next associated item provides the user with a plurality of further options for accessing at least one of the received channel such as selection to tune to another item, selection to tune to a channel to watch, to record, to set a reminder, etc. – figures 13-14b, col. 14, lines 1-67).

Regarding Claim 39, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 15. The additional limitation of “the channel displayed on the display is changed in response to the selection of a particular option from a subsidiary menu” is read on either Knudson discloses of user selection of television icon

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187 to tune to another channel for display program associated with selected channel – figures 13, 24, col. 14, lines 14-27).

Regarding Claim 40, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 39. The additional limitation of “from the received channels a service channel is accessed at a particular display screen within that service channel in dependence on the option chosen within a subsidiary menu” is interpreted as select a channel (e.g. channel associated with icon 187) from the received channels using the “subsidiary menu”, the selected channel is accessed – see Knudson - figures 13, 24, col. 14, lines 1-67).

Regarding Claim 41, Knudson in view of Schein and Alexander discloses a method as discussed in the rejection of claim 15. Knudson further discloses the menus contain regularly updated information (e.g. updated real time information, update program listings data) received together with the program over which the menu are superimposed – see figures 13, 20-24).

Regarding Claim 42, the limitations of the decoder as claimed correspond to the limitations of the method as claim in claim 15, and are analyzed as discussed with respect to the rejection of claim 15. Wherein the decoder is interpreted as the set top box and television display (see Knudson – figure 1). Knudson also discloses the menu as a controller ticker (figure 13). Thus, interference with the program is minimal.

However, Knudson does not disclose control unit is arranged to generate at least one interactive message displayed superimposed over the program, wherein the interactive message require a response from the user, and wherein the interactive message changes to the at least one of the received channels based on a positive reply from the user, wherein the decoder is configured to carry out at least one payment step in response to a positive response to the interactive message from the user.

Schein discloses control unit (e.g., on screen display controller and formatter, microprocessor) is arranged to generate at least one interactive message superimposed over the program (see include, but are not limited to, figures 1,3,11, 17a-17c), wherein the interactive message require a response from the user, and wherein the interactive message changes to the at least one of the received channels based on a positive reply from the user, wherein the decoder is configured to carry out at least one payment step in response to a positive response to the interactive message from the user, wherein the at least one interactive message is suppressed when the service menu is active (see discussion in the rejection of claim 15 above) . Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to modify Knudson to use the teaching as taught by Schein in order to improve convenience for user to order interest channel/program.

Knudson further discloses providing interactive messages including reminder to display with the menu (see include, but are not limited to, col. 8, lines 31-35, col. 9, lines 40-62). However, Knudson does not explicitly disclose the service menu is displayed in inactive form when the at least one interactive message is displayed.

Alexander discloses display multiple windows on the television screen; notification is displayed on the screen and the user response to the notification; There are all sorts of other possibilities for on screen notifications (see include, but are not limited to, provisional application No. 60,055,761: page 3, lines 14-25, page 6, lines 17-23, page 23, lines 12-17). Alexander later discloses on screen notification message is displayed in a number of ways, including 1.) a complete screen overlay; 2.) a partial screen overlay... the EPG screen in Grid guide mode; (see include, but are not limited to, col. 14, line 47-col. 15, line 31). Since the notification is displayed in TV mode and/or the user response to notification on the screen and/or all sorts of possibilities for on screen notification, Alexander obviously suggest the service menu is displayed in inactive form when the at least one interactive message is displayed (e.g., the service menu is displayed as inactive until the user response to notification or until the notification disappears).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Knudson with the teaching as taught by Alexander in order to yield predictable results such as allowing user to activate desired content.

Regarding Claims 43-53, the additional limitations as claimed correspond to the additional limitations of the method as claimed in claims 31-41 respectively, and are analyzed as discussed with respect to the rejection of claims 31-41.



***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SON P. HUYNH whose telephone number is (571)272-7295. The examiner can normally be reached on 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son P Huynh/  
Primary Examiner, Art Unit 2424

September 15, 2009